

REMARKS

Favorable reconsideration, reexamination, and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks.

Summary of Office Action

In the Office Action, beginning at page 2, Claims 1, 3, and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,941,847 to Huber et al. (Huber'847).

In the Office Action, beginning at page 4, Claims 2, 4, 5, 7, 9, 11, 13, 14, 16, 18, 19-21, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Huber'847 in view of U.S. Patent No. 5,885,246 to Ford (Ford'246).

Applicant notes that pending claims 6, 10, and 23 are not treated in the Office Action.

Summary of Response to Office Action

In Response to the August 21, 2007 Office Action, Applicant hereby adds new claims 25-28. Accordingly, claims 1-5, 7, 9-14, 16, 18-21, 23, and 25-29 are currently pending, with claims 8, 15, 17, 22, and 24 having been previously canceled without prejudice or disclaimer. Claims 1 and 5 are the only pending independent claims.

All Claims Are Allowable

Claims 1-5, 7, 9, 11-14, 16, 18-21 and 24 in this application are rejected under various provisions of U.S. law. Applicant respectfully submits that all claims are allowable for the specific reasons set forth below, and therefore requests issuance of this application.

35 U.S.C. § 102(b)

In the Office Action, beginning at page 2, Claims 1, 3, and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Huber'847. Applicant respectfully traverses this rejection and requests reconsideration for the following reasons.

Huber'847 discloses a breast shield with a vacuum isolation element. As shown in Fig. 2 of Huber'847 (reproduced below right), the breast pump 10 includes a hard plastic hood body that has an extension portion 16 with two support braces 22 extending outward from an end of the extension portion 16 to an outer rim 14.

An insert 60 can be placed within and attached to the outer rim 14 while also extending inward along the two support braces 22. The insert 60 is made from flexible latex, as described at column 3 line 28 of the Huber'847 patent.

In the Office Action, the large somewhat rectangular windows between the support braces 22 of the Huber'847 reference are creatively interpreted as framing "at least one vent opening" as recited in claim 1 of the present application.

However, Applicant respectfully submits that the Office Action has overlooked, and Huber'847 fails to show, at least the feature of "a space between the deformable member and the horn member" as recited in the last paragraph of independent claim 1 and the second to last paragraph of independent claim 5. Specifically, there is no disclosure of a "space" between the extension portions 22 (alleged in the Office Action to be the claimed horn member) and the insert 60 (alleged in the Office Action to be the claimed deformable member) in the Huber'847 patent. The "space between the deformable member and the horn member" as recited in claim 1 allows the stimulating convexes to move with respect to the horn member. Therefore, it is respectfully submitted that the creative interpretation of the Huber'847 patent that is being forced to allegedly read on Applicant's claims must end at this failure point. Namely, Huber'847 fails to disclose at

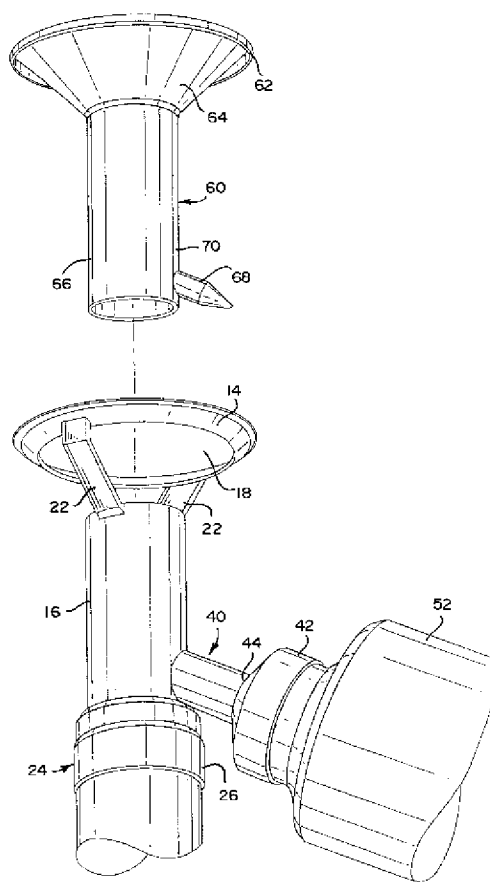


Fig. 2 of Huber'847

least one feature of Applicant's independent claim 1, and therefore there can be no anticipation of the claimed invention by the Huber'847 patent.

It is a common patent law tenet that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). In this case, the Huber'847 patent fails to disclose at least the feature of a space between the deformable member and the horn member, as recited in claim 1. Since the Huber'847 patent fails to disclose each and every feature of claim 1, the Huber'847 patent fails to anticipate claim 1.

Further, since claims 3 and 12 depend from and respectively incorporate all the features of claim 1, claims 3 and 12 are also not anticipated by the Huber'847 patent at least for the above reasons for which claim 1 is not anticipated, and for the separate features that they recite. Thus, Applicant respectfully requests that the rejection of claims 1, 3, and 12 under 35 U.S.C. § 102(b) be withdrawn.

35 U.S.C. § 103(a)

In the Office Action, beginning at page 4, claims 2, 4, 5, 7, 9, 11, 13, 14, 16, 18, 19-21, and 24 were rejected under 35 U.S.C. § 103(a) as reciting subject matter that is allegedly obvious, and therefore allegedly unpatentable, over the disclosure of Huber'847 in view of the disclosure of Ford'246. This rejection is respectfully traversed, and Applicant requests reconsideration for at least the following reasons.

Ford'246 discloses a breast pump insert made of flexible material and including channel portions 17. However, there is absolutely no disclosure or teaching of the feature missing from the Huber'847 patent as noted above. Specifically, neither the Huber'847 patent nor the Ford'246 patent, alone or in alleged combination, disclose or teach at least the feature of a space between a deformable member and a horn member, as recited in independent claims 1 and 5.

Because neither the Ford'246 patent nor the Huber'847 patent, either alone or in combination, teach the above-referenced feature, as well as other features, of Applicant's claims 1 and 5, it is respectfully submitted that there is no *prima facie* case for obviousness.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any specific evidence of nonobviousness by Applicant.

In order to establish a *prima facie* case of obviousness, the Office must satisfy three requirements. M.P.E.P. § 2142. First, "the prior art reference, or references when combined, must teach or suggest *all* the claim limitations." *Id.* (emphasis added). Second, the Office must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." *Id.* Finally, "there must be a reasonable expectation of success." *Id.*

In the present case, as stated above, neither of the cited references either alone or in combination teaches or suggests at least the feature of a space between the deformable member and the horn member, as recited in independent claims 1 and 5. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to claims 1 and 5.

The Office Action fails to meet all three requirements for establishing a *prima facie* case of obviousness. Therefore, Applicant respectfully requests that the rejection of claim 5 under 35 U.S.C. § 103(a) be withdrawn.

Further, since claims 2, 4, 5, 7, 9, 11, 13, 14, 16, 18, and 19-21 depend from and respectively incorporate all the features of claim 1, claims 2, 4, 5, 7, 9, 11, 13, 14, 16, 18, and 19-21 are also not obvious over the Huber'847 patent in view of the Ford'246 patent at least for the above reasons for which claim 1 is not obvious, and for the separate features that each of these claims recites.

With regard to claim 24, this claim was previously cancelled without prejudice or disclaimer and therefore the rejection should be moot.

Thus, Applicant respectfully requests that the rejection of claims 2, 4, 5, 7, 9, 11, 13, 14, 16, 18, 19-21, and 24 under 35 U.S.C. § 103(a) be withdrawn.

New Claims

New claims 25-28 are added to provide an alternate scope of protection for the invention. It is respectfully submitted that these new claims are also in immediate form for allowance. Early and favorable examination of all claims is respectfully requested.

Conclusion


Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of this patent application is therefore respectfully solicited.

If the patent examiner believes that a further telephone conference with the undersigned would expedite passage of this patent application to issue, he is invited to call on the number below.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees

necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account listed on Applicant's initial application filing transmittal document.

Respectfully submitted,
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